

REMARKS

Claims 1, 4-9, and 12 are now pending in the application. By this amendment, independent claim 1 has been amended and new independent claim 12 has been added. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

The Examiner found confusing the order in which the first and second mixing steps and the pH adjusting step were performed. Accordingly, claim 1 has been amended to move the second mixing step so that it is recited as being after the pH adjusting step. Claims 10 and 11 have been cancelled.

The Examiner also found confusing applicants' preamble recitation of the water-soluble solubilizing group and of the additive. Accordingly, applicants have amended the preamble in two places, to indicate that the water-soluble is selected from the group consisting of...; and similarly that the additive includes at least one selected from the group consisting of... Thus it is now believed clear what these preamble elements are referring to.

It is therefore respectfully submitted that any confusion in the wording of the claims has been corrected. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102

Claims 1, 3-5 and 7-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 02/072719 taken in view of the evidence given in Shimizu et al. (U.S. 5,928,220). Reconsideration is respectfully requested in light of the amendments.

WO 02/072719 relates to an ink and methods of preparing an ink having a water-soluble dye. The Examiner cites 5,928,220 as disclosing Acid Black 2 having a sulfonic group for water solubilizing.

While the cited references do disclose methods of making ink compositions with similar ink components to the present invention, the references do not describe the applicants' method of preparation which employs steps in the following order:

- 1) mixing the dye and condensation polymerizable silane (before adding other ink components);
- 2) adjusting pH; and
- 3) adding an additive of an organic acid or inorganic acid salt.

Applicants claim 1, as amended, recites the adjusting pH step as being between the first mixing step and the second mixing step. Thus order of steps is not found in the cited references. Accordingly, it is respectfully submitted that the claims as amended now distinguish over the cited references.

New claim 12 has been added by this amendment. The Examiner will note that the same order of steps (discussed above) is recited. In addition, new claim 12 provides further recitation of the cation of the additive.

REJECTION UNDER 35 U.S.C. § 103

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soga et al. (U.S. Pat. No. 6,929,686) in view of WO 02/072719 and Kanaya et al. (U.S. Pat. No. 5,985,015). Claims 10 and 11 have been cancelled. Therefore this rejection has been rendered moot.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-0750, under Order No. 5077-000209/US from which the undersigned is authorized to draw.

Dated: March 19, 2007

Respectfully submitted,

Electronic signature: /Gregory A. Stobbs/
Gregory A. Stobbs
Registration No.: 28,764
HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1214
Attorney for Applicant